

REMARKS

Claims 13 and 16-30 are pending in the present application after cancellation of claims 14 and 15. Claims 29 and 30 have been withdrawn from further consideration. Claims 13, 16-17, 21-15 and 27 have been amended. In view of the foregoing amendments and the following remarks, Applicants submit that all pending claims under consideration are in allowable condition.

35 U.S.C. 112 Rejection

The Examiner rejected claims 17 and 18 as being indefinite because of the use of the trademark "TEFLON." In response, claims 17 and 18 have been amended to recite the chemical term "polytetrafluoroethylene." Withdrawal of the indefiniteness rejection is requested.

35 U.S.C. 102(a) Rejection

The Examiner rejected claims 13-14, 16-18 and 21-22 under 35 U.S.C. § 102(a) as being anticipated by Applicants' own admitted prior art ("APA"). Claim 14 has been canceled. Applicants submit that this rejection should be withdrawn for at least the following reasons.

To anticipate a claim under 35 U.S.C. § 102(a), a single prior art reference must identically disclose each and every claim feature. See Lindeman Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claim feature is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). Additionally, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). To the extent that the Examiner may be relying on the doctrine of inherent disclosure for the anticipation rejection, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Amended independent claim 13 recites, in relevant parts, “a silicon layer; and a **passivating layer** at least regionally and superficially **deposited on the silicon layer**, wherein **the passivating layer has a substantially inorganic first partial layer and a substantially polymer second partial layer**, and wherein **the first partial layer is substantially made of an oxide layer, and wherein the first partial layer has a thickness of 1 nm to 100 nm.**”

Although the Examiner contends that page 2, lines 1-15 of Applicants’ own specification teach that “**the passivating layer has a substantially inorganic first partial layer and a substantially polymer second partial layer**,” there is simply no such disclosure in the section of the Applicants’ specification cited by the Examiner; instead, the cited section only mentions depositing a passivating layer of a Teflon polymer. In addition, there is simply no suggestion in “APA” regarding the claimed limitation that “**the first partial layer is substantially made of an oxide layer, and wherein the first partial layer has a thickness of 1 nm to 100 nm.**”

For at least the foregoing reasons, the anticipation rejection of claim 13 and its pending dependent claims 16-18 and 21-22 based on APA should be withdrawn.

35 U.S.C. 102(e) Rejection

The Examiner rejected claims 13-24 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,284,657 (“Chooi”). Claims 14 and 15 have been canceled. Applicants submit that this rejection should be withdrawn for at least the following reasons.

To anticipate a claim under 35 U.S.C. § 102(e), a single prior art reference must identically disclose each and every claim feature. See Lindeman Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claim feature is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). Additionally, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). To the extent that the Examiner may be relying on the doctrine of inherent disclosure for the

anticipation rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Amended independent claim 13 recites, in relevant parts, “a silicon layer; and a **passivating layer** at least regionally and superficially **deposited on the silicon layer**, wherein **the passivating layer has a substantially inorganic first partial layer and a substantially polymer second partial layer**, and wherein **the first partial layer is substantially made of an oxide layer, and wherein the first partial layer has a thickness of 1 nm to 100 nm.**”

In support of the rejection, the Examiner contends the following: a) layer 12 of Chooi is equivalent to the claimed “silicon layer”; b) layer 16 of Chooi is equivalent to the claimed “substantially inorganic first partial layer” of the passivating layer; and c) layer 14/18 is equivalent to the claimed “substantially polymer second partial layer” of the passivating layer. However, Applicants note that this asserted interpretation is clearly contrary to the actual disclosure of Chooi: Chooi clearly states that layer 16 is an etch-stop layer, and that layer 12 is the passivating layer. Accordingly, there is clearly no suggestion in Chooi regarding a passivating layer that has a substantially inorganic first partial layer and a substantially polymer second partial layer. In addition, given the fact that Chooi clearly does not suggest a passivating layer that has a substantially inorganic first partial layer and a substantially polymer second partial layer, Chooi clearly cannot (and does not) suggest the additional limitations that **the first partial layer of the passivating layer is substantially made of an oxide layer and has a thickness of 1 nm to 100 nm.**

Independent of the above, to the extent the Examiner contends that “the partial layer of silicon oxide amounting to 1nm (10A) to 100 nm (1000A) may be deposited upon [further] silicon oxide since the total thickness of silicon oxide may be 5000A,” this contention is only a purely theoretical speculation which cannot support the conclusion that **Chooi actually teaches or enables the claimed feature.**

For at least the foregoing reasons, claim 13 and its pending dependent claims 16-24 are not anticipated by Chooi. Withdrawal of the anticipation rejection is requested.

Allowable Subject Matter

The Examiner objected to claims 25-28 as being dependent upon a rejected base claim, but the Examiner also indicated that these claims contain subject matter that would be allowable if rewritten in independent form. Claims 25-28 ultimately depend on independent claim 13. As explained above, claim 13 is allowable over the applied prior art. Accordingly, dependent claims 25-28 are allowable in their present dependent form.

Conclusion

In view of the foregoing, it is respectfully submitted that all of the presently pending claims under consideration are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

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